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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,913	10/10/2003	Timothy P. Blair	200300432-1	3073

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EXAMINER
BHAT, ADITYA S

ART UNIT	PAPER NUMBER
2863	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/683,913	BLAIR, TIMOTHY
	Examiner	Art Unit	
	Aditya S. Bhat	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 November 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-12,14-28,30-32 and 34-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-12,14-28,30-32 and 34-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

Applicant is requested to provide information/prior art that are relevant to

applicant's disclosure, particularly figures 2-4. In order to reach a full and proper

consideration of the issues raised herein, it is necessary to obtain additional information

from applicant regarding the aforementioned issues.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-22, and 37-42 are rejected under 35 U.S.C. 102(b) as being

anticipated by Blair et al. (USPUB 2005/0080597) (applicant admitted prior art, figs 2-4).

With regards to claim 21, Blair et al. (AAPA, fig. 2-4)discloses an appliance for

monitoring equipment comprising:

a data port for receiving data from said equipment; (38;figure 2)

a communication module for receiving one or more software components, each

software component for processing said equipment data in accordance with an optional

service, and for receiving a set of configuration data adapted to enable or disable said

software components; (40;figure 2)

a memory for storing said software components; (34;figure 2)and

a processor for executing said software components in accordance with said

configuration data. (32;figure 2)

With regards to claim 22, Blair et al. (AAPA, fig. 2-4) discloses an appliance for

monitoring one or more office equipment devices comprising:

a data port for receiving data from said equipment; (38;figure 2)

software adapted primarily for monitoring said devices, said software including

one or more software components, each software component for processing said

equipment data in accordance with an optional service; (36;fig 2)

a communication module for receiving a set of configuration data adapted to

enable or disable said software components, wherein said software components

comprise at least software with instructions for monitoring a different appliance; (40;

figure 2)

a memory for storing said software; (34;figure 2) and

a processor for executing said software in accordance with said configuration

data. (32;figure 2)

With regards to claim 37, Blair et al. (AAPA, fig. 2-4) discloses a system for

monitoring office equipment comprising:

one or more monitoring appliances adapted to monitor said office equipment,

each monitoring appliance including: (30;figure 2)

a data port for receiving data from said equipment; (38;figure 2)

appliance software adapted primarily for monitoring said equipment, said

software including one or more software components, each software component for

processing said equipment data in accordance with an optional service, wherein said

optional service includes functionality for monitoring a different appliance; (figure 2)

a first communication module for receiving a set of configuration data adapted to

enable or disable said software components; (figure 2)

a first memory for storing said appliance software; (figure 2)and

a first processor for executing said software in accordance with said configuration

data; (figure 2)and

a central server including: (back office; figure 4)

server software for controlling the communication of data to and from said

monitoring appliances; (figure 4)

a first database of configuration data for said monitoring appliances; (figure 4)

a second memory for storing said server software and said first database; (fig 4)

a second processor for executing said server software; (66; figure 12)and

a second communication module for transmitting said configuration data to said

monitoring appliances. (back office; figure 2&4)

With regards to claim 38, Blair et al. (AAPA, fig. 2-4) discloses an application for

modifying the configuration data stored in said first database. (figure 4)

With regards to claim 39, Blair et al. (AAPA, fig. 2-4)discloses server further

includes a second database of new or upgraded software components. (figure 4)

With regards to claim 40, Blair et al. (AAPA, fig. 2-4)discloses first and second

communication means are also adapted to download new or upgraded software

components from said central server to said monitoring appliances. (figure 4)

With regards to claim 41, Blair et al. (AAPA, fig. 2-4)discloses configuration data is

adapted to enable or disable a new or upgraded software component. (figure 4)

With regards to claim 42, Blair et al. (AAPA, fig. 2-4)discloses system for

monitoring office equipment comprising:

one or more monitoring appliances adapted to monitor said office equipment,

each monitoring appliance including: (figure 2)

a data port for receiving data from said equipment; (figure 2)

a first communication module for receiving one or more software components,

each software component for processing said equipment data in accordance with an

optional service, and for receiving a set of configuration data adapted to enable or

disable said software components; (40;figure2)

a first memory for storing said software components; (34 ;figure 2) and

a first processor for executing said software components in accordance with said

configuration data; (32;figure 2) and

a central server (back office ;figure 2) including:

server software for controlling the communication of data to and from said

monitoring appliances; (figure 4)

a first database of configuration data for said monitoring appliances; (figure 3)

a second database of software components for said monitoring appliances;

(50;figure 4)

a second memory for storing said server software and said first and second

databases; (back office; figure 4)

a second processor for executing said server software; (back office; figure 4)and

a second communication module for transmitting said configuration data and.

said software components to said monitoring appliances. (back office; figure 2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 9-12, 14-20,23-28, 30-32, 34-36 and 42 are rejected under 35 U.S.C.

103(a) as being unpatentable over Blair et al. (USPUB 2005/0080597) (applicant

admitted prior art, figs 2-4) in view of St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With regards to claim 1, Blair et al. (AAPA, fig. 2-4)discloses an appliance for

monitoring equipment comprising:

first means for receiving data from said equipment; (38;fig 2)

second means for receiving a set of configuration data(42;figure 3), wherein said

second means includes a communication module; (40;figure 2)(figure 4) and

third means for processing said equipment data in accordance with a optional

service, (32,36;fig 2) wherein said configuration data is adapted to enable or disable

said optional services,(60-62; figure 4) wherein said appliance is adapted to restart

upon receiving a restart signal form said communication module. (66;figure 4)

Blair et al. (AAPA, fig. 2-4)discloses the claimed invention except for a plurality of services. It would have been obvious to one having ordinary skill. in the art at the time the invention was made to-, :since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With regards to claim 2 and 29, Blair et al. (AAPA, fig. 2-4) discloses said third means includes:

software for processing said equipment data, (36;fig 2) said software including one or more software components, each software component for performing an optional service; (36;figure 2) fourth means for storing said software; (34;figure 2) and

fifth means for executing said software in accordance with said configuration data, which is adapted to enable or disable said software components. (72;figure 12)

With regards to claim 3, Blair et al. (AAPA, fig. 2-4)discloses fourth means is a memory. (34;figure 2)

With regards to claim 4, Blair et al. (AAPA, fig. 2-4)discloses memory is also adapted to store said configuration data. (34;figure 2)

With regards to claim 5, Blair et al. (AAPA, fig. 2-4)discloses a fifth means is a processor. (32;figure 2)

With regards to claim 6, Blair et al. (AAPA, fig. 2-4)discloses a first means includes one or more data ports. (38;figure 2)

With regards to claim 7, Blair et al. (AAPA, fig. 2-4)discloses data ports are also adapted to transmit data to said equipment. (64;figure 4 & 38;figure 2)

With regards to claim 9, Blair et al. (AAPA, fig. 2-4)discloses means for transmitting data to a remote system. (52;figure 4) (40;figure 2)

With regards to claim 10, Blair et al. (AAPA, fig. 2-4)discloses means for receiving new or upgraded software components. (figure 4)

With regards to claim 11, Blair et al. (AAPA, fig. 2-4) discloses configuration data is adapted to enable or disable a new or upgraded software component. (figure 4)

With regards to claims 16-18, Blair et al. (AAPA, fig. 2-4) discloses the communication module is coupled to an Internet connection either a dialup or wireless. (40;figure 2)

With regards to claim 19, Blair et al. (AAPA, fig. 2-4) discloses the appliance is a stand-alone device separate from said equipment. (30; figure 2)

With regards to claim 20, Blair et al. (AAPA, fig. 2-4) discloses the equipment includes one or more printers. (fig 2)

With regards to claim 23, Blair et al. (AAPA, fig. 2-4) discloses a system for monitoring equipment comprising:

one or more monitoring appliances adapted to monitor said equipment, each monitoring appliance including (30;figure 2)

first means for receiving data from said equipment; (38;figure 2)

second means for receiving a set of configuration data; (32,40;figure 2) and

third means for processing said equipment data in accordance with a plurality of optional services, wherein said configuration data is adapted to enable or disable said optional services; (32;figure 2) wherein said third means includes:

software for processing said equipment data, (36;figure 2)said software including one or more software components, each software component for performing an optional service, wherein said software component for performing an optional service, wherein said software is adapted to restart said monitoring appliance after receiving and storing said configuration data; (figure 4) and

a memory for storing said software; (34 figure 2) and

a processor for executing said software in accordance with said configuration data, which is adapted to enable or disable said software components; (32;figure 2) and

fourth means for transmitting said configuration data to said monitoring appliances. (62;figure 4)

With regards to claim 24, Blair et al. (AAPA, fig. 2-4)discloses a fourth means includes a central server. (20;figure 1A)

With regards to claim 25, Blair et al. (AAPA, fig. 2-4)discloses a central server includes a first database of configuration data for the monitoring appliances. (50;figure 4)

With regards to claim 26, Blair et al. (AAPA, fig. 2-4)discloses a user can change which services in a monitoring appliance are enabled or disabled by modifying the configuration data for that monitoring appliance stored in said first database. (42;figure 3)

With regards to claim 27, Blair et al. (AAPA, fig. 2-4)discloses a central server includes an application for modifying the configuration data stored in said first database. (20;figure 1A)

With regards to claim 28, Blair et al. (AAPA, fig. 2-4) discloses an application is a web application. (figure 4)

With regards to claim 30, Blair et al. (AAPA, fig. 2-4)discloses a central server includes a second database of new or upgraded software components. (figure 4)

With regards to claim 31, Blair et al. (AAPA, fig. 2-4) discloses monitoring appliances further include means for receiving new or upgraded software components from said central server(figure 4)

With regards to claim 32, Blair et al. (AAPA, fig. 2-4) discloses configuration data is adapted to enable or disable a new or upgraded software component. (figure 3)

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 43-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a judicial exception; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106)), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely restarting said monitoring appliance with said software components enabled or disabled

from execution in accordance with said configuration data would not appear to be

sufficient to constitute a tangible result, since the outcome of the restarting step has not

been used in a disclosed practical application nor made available in such a manner that

its usefulness in a disclosed practical application can be realized. As such, the subject

matter of the claims is not patent eligible.

In order to overcome the rejection, claim language should be added that includes

outputting, displaying storing or otherwise conveying the result of the previous method

steps.

For further clarification please refer to the Interim Guidelines for Examination of

Patent Applications for Patent Subject Matter Eligibility which can be found on the

following website;

http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm

Response to Arguments

Applicant's arguments with respect to claims 1-7, 9-12, 14-28, 30-32, and 34-46

have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Mathiesen et al. (USPUB 2003/0135381) teaches an automated

distributed printing system, and Carney et al. (USPN 6,453,268) teaches methods,

systems and program for monitoring a device with a computer using user selected
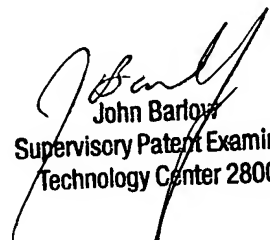
monitoring settings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditya S. Bhat whose telephone number is 571-272-2270. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aditya Bhat
April 2, 2007

John Barlow
Supervisory Patent Examiner
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